

Remarks

The non-final Office Action dated April 16, 2009, notes an objection to the drawings; an objection to the Specification; and an objection to claims 1, 6-8, 11-12, 16-17, 20 and 22 due to informalities. The following rejections are presented: claims 20-26 stand rejected under 35 U.S.C. § 102(b) over Thierry (WO 99/60510); claims 1-2, 4-5 and 9-10 stand rejected under 35 U.S.C. § 103(a) over MacLellan (U.S. Patent No. 5,940,006) in view of Shigyo (U.S. Patent No. 6,430,209); claims 11-12, 14 and 19 stand rejected under 35 U.S.C. § 103(a) over the ‘006 reference in view of the ‘209 reference; claims 3, 8, 13 and 18 stand rejected under 35 U.S.C. § 103(a) over the ‘006 and ‘209 references in view of the Okumura reference (U.S. Patent No. 2003/0003942). Claims 6-7 and 16-17 are objected to but would be allowable if rewritten in independent form. In the following discussion, Applicant does not acquiesce in any regard to averments in this Office Action (unless Applicant expressly indicates otherwise).

Applicant respectfully traverses the § 102(b) rejection of claims 20-26 because the cited ‘510 reference does not correspond to aspects of the claimed invention directed to a reader transmitting commands that do not include synchronization information to an RFID transponder. The Office Action erroneously asserts that the ‘510 reference teaches these aspects of the claimed invention because the ‘510 reference does not mention that the SHIFT and MUTATED signals contain synchronization information. Applicant submits that it is improper for the Office Action to assert correspondence to the claimed invention based on the lack of teachings in the ‘510 reference. The ‘510 reference does not teach that the SHIFT and MUTATED signals do not contain synchronization information and, as such, there is no correspondence to the claimed invention. Instead, it is a mere possibility that the SHIFT and MUTATED signals might not contain synchronization information, and a rejection cannot be based on mere possibilities. *See, e.g.*, M.P.E.P. § 2112. Accordingly, the § 102(b) rejection of claims 20-26 is improper and Applicant requests that it be withdrawn.

Applicant further traverses the § 102(b) rejection of claims 20-26 because the English translation of the ‘510 reference provided with the Office Action is insufficient to allow Applicant to determine the propriety of the rejection. According to M.P.E.P. § 706.02, “If the document is in a language other than English and the Examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the

precise facts the Examiner is relying upon in support of the rejection.” Applicant is unable to determine the propriety of the rejection because the provided machine generated English translation of the ‘510 reference is incomplete. In particular, the machine translation contains words that have not been translated to English and the text in the Figures of the ‘510 reference has not been translated at all. As such, Applicant is unable to ascertain the entire teachings of the ‘510 reference and is thus unable to determine the propriety of the rejection. Applicant notes that the lack of a complete translation of the ‘510 reference is particularly troubling in view of the fact that the basis for the rejection is the Office Action’s assertion that the ‘510 reference does not mention that the SHIFT and MUTATED signals contain synchronization information. Applicant is unable to ascertain the propriety of this assertion due to the incomplete translation. Should any rejection based on the ‘510 reference be maintained, Applicant submits that the Examiner must provide a complete and accurate English translation of the ‘510 reference.

Applicant respectfully traverses the § 103(a) rejections because the cited ‘006 reference either alone or in combination with the ‘209 reference lacks correspondence. For example, neither of the asserted references teaches the claimed invention “as a whole” (§ 103(a)) including aspects regarding, e.g., a reader transmitting commands that do not include synchronization information to an RFID transponder. Because none of references teach these aspects, no reasonable interpretation of the asserted prior art, taken alone or in combination, can provide correspondence. As such, the rejections fail.

More specifically, the ‘006 reference teaches that the primary purpose of Downlink signal 103, which is sent by interrogator 101 to tags 102, is to allow the tags 102 to achieve synchronization with the interrogator 101. *See, e.g.* Figure 2 and Col. 4:8-12. The ‘006 reference does not teach sending a Downlink signal 103 that does not contain synchronization information, as in the claimed invention. In addition, the system of the ‘209 reference does not include RFID transponders that communicate with a reader. Instead, the ‘209 reference is directed to cordless telephone apparatus. *See, e.g.*, Figure 1 and Col. 2:52-58. Thus, the 209 reference does not teach transmitting commands that do not include synchronization information to an RFID transponder, as claimed. Accordingly, no reasonable interpretation of the asserted prior art, taken alone or in combination, can provide correspondence because none of the references teach such aspects of the claimed invention.

Moreover, the cited references teach away from the Office Action's proposed combination. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main ('006) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."). In this instance, the Office Action erroneously concludes that the skilled artisan would combine teachings of the '209 reference directed to a cordless telephone apparatus with the RFID tags 102 of the '006 reference in order "to reduce power consumption of the RFID device." Applicant notes that the '209 reference does not even mention that power consumption is reduced in its cordless telephone apparatus, but somehow the Office Action concludes that applying these entirely unrelated teachings to the RFID tags 102 of the '006 reference would reduce power consumption. Applicant submits that the '006 and '209 references teach away from the combination of wholly unrelated teachings (as proposed by the Office Action) based upon mere speculation with regard to the reduction of power consumption.

In view of the above, the § 103(a) rejections are improper and Applicant requests that they be withdrawn.

In view of the above, Applicant believes that each of the rejections is improper and should be withdrawn and that the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9063 (or the undersigned).

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